



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

BRIAN H BATZLI
MERCHANT & GOULD PC
PO BOX 2903
MINNEAPOLIS MN 55402-0903

COPY MAILED

MAR 21 2005

OFFICE OF PETITIONS

In re Reissue Application of:
Lee et al.
Reissue Application No. 09/933,918
Filed: August 21, 2001
Original Patent No. 5,637,345
Issue Date: June 10, 1997
For: METHOD OF MANUFACTURING
POWDERED DEER BLOOD

:
:
:
:
: DECISION DENYING PETITION
:
:
:

This is a decision on the petition filed by facsimile transmission November 29, 2004, and the petition styled as a "request under 37 CFR §§ 1.182 and 1.183" filed by facsimile transmission January 3, 2005, which are collectively being treated as a petition under 37 CFR 1.183 to waive the rules and to withdraw or amend the terminal disclaimer recorded against the above-identified patent.

The petition under 37 CFR 1.183 to waive the rules and withdraw or amend the terminal disclaimer recorded against the above-identified patent is DENIED.

BACKGROUND

Application No. 08/584,748('748) was filed January 11, 1996, styled as a continuation in part of application No. 08/284,159 filed August 2, 1994, which issued as U.S. Patent No. 5,05,980('980) on April 9, 1996.

The Office action of June 3, 1996, in the '748 application contained, *inter alia*, a rejection of the claims on the judicially created doctrine of obviousness type double patenting over the claims of the '980 patent.

On September 6, 1996, a terminal disclaimer was filed as part of the reply to the above-noted rejection. However, the disclaimer was drawn to U.S. Patent No. 5,460,677 ('677), which pursuant to 35 U.S.C. §154(c)(1) expires October 24, 2012, some 22 months earlier than the '980 patent relied upon in the Office action, which expires August 2, 2014.

The '748 application issued as U.S. Patent No. 5,637,345('345) on June 10, 1997, with the terminal disclaimer in full force and effect, as indicated by the entry on the front page of the patent that the term of the '345 patent did not extend beyond that of the '677 patent.

The instant application for reissue of the '345 patent was filed on August 21, 2001.

A petition under 37 CFR 1.182 was filed July 2, 2002, in this application for reissue and requested that the terminal disclaimer recorded in the patent be withdrawn.

The petition under 37 CFR 1.182 was denied in the final agency action of June 28, 2004.

A petition styled as a "new alternative request and response" under 37 CFR 1.182 to the above-noted final agency action was filed by facsimile transmission November 29, 2004.

A further petition styled as a "request under 37 CFR §§ 1.182 and 1.183" was filed by facsimile transmission January 3, 2005.

STATUTE AND REGULATION

35 U.S.C. § (2)(b)(2) provides, in pertinent part, that:

The Office...may establish regulations, not inconsistent with law,
which...

(A) shall govern the conduct of proceedings in the Office.

35 U.S.C. § 251 states:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Director may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the

original patent unless applied for within two years from the grant of the original patent.

35 U.S.C. § 253 states in pertinent part:

A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, and recorded in the Patent and Trademark Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

37 CFR 1.183 provides that:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(h).

37 CFR 1.321 states in pertinent part:

(b) An applicant or assignee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of a patent to be granted. Such terminal disclaimer is binding upon the grantee and its successors or assigns. The terminal disclaimer, to be recorded in the Patent and Trademark Office, must:

(1) be signed:

- (i) by the applicant, or
- (ii) if there is an assignee of record of an undivided part interest, by the applicant and such assignee, or
- (iii) if there is an assignee of record of the entire interest, by such assignee, or
- (iv) by an attorney or agent of record;

(2) specify the portion of the term of the patent being disclaimed;

(3) state the present extent of applicant's or assignee's ownership interest

in the patent to be granted; and

(4) be accompanied by the fee set forth in § 1.20(d).

(c) A terminal disclaimer, when filed to obviate a judicially created double patenting rejection in a patent application or in a reexamination proceeding, must:

(1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;

(2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding; and

(3) Include a provision that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the rejection.

37 CFR 1.325 states:

Mistakes other than those provided for in §§ 1.322, 1.323, 1.324, and not affording legal grounds for reissue or reexamination, will not be corrected after the date of the patent.

OPINION

Petitioner is reminded that the USPTO has already issued a final agency action on the merits of the request presented and considered under 37 CFR 1.182, and, as such, there is no reason given or apparent why the limited resources of the USPTO should be again expended considering 37 CFR 1.182 relief.¹ This is particularly so in that to the extent that these later petitions request reconsideration of the adverse decision of June 28, 2004, they are subject to dismissal as untimely presented. See 37 CFR 1.181(f)((f) in pertinent part:

"[a]ny petition under this part not filed within two months of the mailing date of the

¹ 37 CFR 1.182 is not a mechanism for avoiding the requirements of the established rules and procedures, see Hicks v. Costello, 1903 Dec. Comm'r Pat. 123, 125 (Comm'r Pat. 1903).

action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable."

Accordingly, the issues under 37 CFR 1.182 will not be revisited, and this decision is limited to considering petitioner's alternate request for waiver of the rules under 37 CFR 1.183.

Initially, petitioner does not make clear which rule(s), or which part of a rule(s), which petitioner seeks to waive, but it is presumed that petitioner seeks waiver of whatever unspecified rule or rules which operate to prevent withdrawal or amendment of the terminal disclaimer that has been of record in the original application since September 6, 1996, and publicly available since the issue date of June 10, 1997.

Waiver of the Rules and Withdrawal or Amendment of the Recorded Terminal Disclaimer
Would Be Inconsistent with the Applicable Statutes

It is noted that petitioner has remedied the previous omission of a terminal disclaimer over the '980 patent by filing the terminal disclaimer in this reissue on July 3, 2002. The issue of waiver of the rules only arises as part of petitioner's attempt to also remove the effect of the terminal disclaimer filed September 6, 1996, from the as-issued patent. However, the fact that reissue is also being invoked brings additional statutory considerations, as 37 CFR 1.183, by its express terms, may not be invoked to operate to the contrary of any statute.

Since the instant reissue application was filed more than two years after the issue date of the original patent, 35 U.S.C. § 251 prohibits broadening of any of the claims of the original patent in and by way of this reissue application. Accordingly, waiver of the rules so as to permit removal or amendment of the effect of the terminal disclaimer filed September 6, 1996, would facially appear to constitute "vertical" broadening of the claims of the above-identified patent, which is now expressly prohibited by the statute. See Ex Parte Anthony, 230 USPQ 467 (BPAI 1982) aff'd, No. 84-1357 (Fed. Cir. June 14, 1985). As held in Anthony, removal of a recorded terminal disclaimer, and the resultant "broadening" of the vertical scope (term) of the original patent, is prohibited, *inter alia*, if the attempt via reissue is not sought within two years of the patent grant. Id. at 470. It would be an improper exercise of 37 CFR 1.183 to permit petitioner to regain, on petition, what petitioner could not herein regain under the remedial patent statute, which, as such, is "liberally construed." Indeed, as the Federal Circuit noted in In re Weiler, 790 F.2d 1576, 229 USPQ 673 (Fed. Cir. 1986):

The reissue statute was not enacted as a panacea for all patent prosecution problems, nor as a grant to the patentee of a second opportunity to prosecute de novo his original application.

Here, petitioner seeks a second opportunity, via reissue, to remove the terminal disclaimer of September 6, 1996, which petitioner knew, or should have known, had to be requested prior to issuance of the original patent on June 10, 1997. See MPEP1490 (B).² Accordingly, waiver of the rules in this instance would operate to the contrary of 35 U.S.C. § 251, which exceeds the scope of 37 CFR 1.183.

Furthermore, by statute, the USPTO may only issue a reissue patent "for the unexpired part of the term of the original." See 35 U.S.C. § 251. What petitioner here seeks, on belated petition for waiver in this reissue, is to effectuate a change in "the unexpired part of the term" of this patent. However, the term of this patent was set by way of 35 U.S.C. § 154(b), and, by way of the disclaimer filed September 6, 1996, under § 253.³ Since the patent statute at sections §§154, 155, 155(a), and 156 limits the adjustment, extension, or restoration, of the term of a given patent to the causes and conditions specified therein; it would be inappropriate, by way of a petition under 37 CFR 1.183 to fashion yet another manner of adjusting, extending, or restoring, the term of the above-identified patent beyond the statutory scheme already provided by Congress. This is particularly so in that a standard principle of statutory construction is: *expressio unius est exclusion alterius* (the mention of one thing implies exclusion of another thing), namely absent legislative intent to the contrary, when a statute expressly provides a specific remedy for a specific situation, the statute is deemed to exclude other remedies for such situation. See National R.R. Passenger Corp. v. National Ass'n Of R.R. Passengers, 414 U.S. 453, 458 (1974); see also Botany Worsted Mills v. United States, 278 U.S. 282, 289 (1929) ("when a statute limits a thing to be done in a particular mode, it includes the negative of any other mode"). That is, the patent statute at sections 35 U.S.C. §§ 154, 155, 155(a), and 156 (and their promulgating regulations at 37 CFR 1.701 et seq.) provides a specific mechanism grounded on specific delays (arising from judicial, regulatory agency, or internal USPTO delay) whereby a party may petition the USPTO to adjust, extend, or restore the term of a given patent. However those remedies and their underlying causes are immaterial to the

² The MPEP has no binding force on the courts, but it commands notice as an official interpretation of statutes and regulations with which it does not conflict. Patent attorneys, examiners, and the public commonly rely on the MPEP as a guide in procedural matters. In re Kaghan, 387 F.2d 398, 401, 156 USPQ 130, 132 (CCPA 1967); Syntex v. U.S. Patent and Trademark Office, 882 F.2d 1570, 1571 n.3, 11 USPQ2d 1866, 1867 n.3 (Fed. Cir. 1989); Litton Sys., Inc. v. Whirlpool Corp., 728 F.2d 1423, 1439, 221 USPQ 97, 107 (Fed. Cir. 1984).

³ As noted in MPEP 1405:

The maximum term of the original patent is fixed at the time the patent is granted. While the term may be subsequently shortened, e.g., through the filing of a terminal disclaimer, it cannot be extended through the filing of a reissue.

above-captioned patent.⁴ Nevertheless, since Congress has already enacted legislation for patent term adjusting, extending, or restoring provisions in four sections (154, 155, 155(a), and 156) of the patent statute, and has not seen fit to create any additional statutory term modifying remedies, it is inappropriate for the USPTO to now create an additional, extra-legislative means of adjusting, extending, or restoring, the term of the original patent by now removing or amending the terminal disclaimer filed September 6, 1996, by way of petition under 37 CFR 1.183 (or 1.182) in this reissue application.

Further, in any event, it is not seen how waiver of the rules and removal of the terminal disclaimer in question, and thus lengthening the "unexpired part of the term" by way of petition in this reissue application would be consistent with the express statutory requirement that the USPTO reissue the instant reissue application for the "for the unexpired part of the term of the original patent," which here issued with the contested disclaimer and its term limiting provisions arising under 35 U.S.C. § 253 and 37 CFR 1.321(b). See 35 U.S.C. § 251. As the court observed in In re Orita, 550 F.2d 1277, 193 USPQ 145 (CCPA 1977):

"[s]ection 251 is not a panacea designed to cure every mistake which might be committed by an applicant or his attorney, and the case at bar exemplifies a mistake which this section cannot cure."

It follows that 37 CFR 1.183, which is necessarily subservient to all other sections of the patent statute, cannot be properly employed to accomplish that which would contravene two requirements of § 251, and create yet another patent term adjustment provision

⁴ The twenty-year maximum term of a patent that, as here, issued from an application filed on or after June 8, 1995, and before May 29, 2000, can only be extended for a maximum of five years for delays in the issuance of the patent due to (1) interferences; (2) secrecy orders; and/or (3) successful appeals to the Board of Patent Appeals and Interferences or the Federal courts in accordance with 37 CFR 1.701. See former 35 U.S.C. 154(b)(1995). Even then, Congress limited extensions for successful appeals in that the patent must not be subject to a terminal disclaimer. Further, the period of extension is reduced by any time attributable to appellate review within three years of the filing date of the first national application for patent, and the period of extension for appellate review is reduced by any time during which the applicant did not act with due diligence. Any patent term extension that may be available under 35 U.S.C. § 156 for premarket regulatory review is separate from and is added to any extension that may be available under former and current 35 U.S.C. § 154. Thus, Congress placed various numerous conditions and limitations on patent term adjustment, including a requirement for diligence, a condition not demonstrated here.

beyond those enacted at sections §§154, 155, 155(a), and 156.⁵ See Baxter Int'l, Inc. v. McGaw, Inc., 149 F.3d 1321, 1334, 47 USPQ2d 1225, 1234-1235 (Fed. Cir. 1998)(the PTO cannot, by rule, or waiver of the rules, fashion a remedy that contravenes 35 USC §§ 112, 120); A. F. Stoddard v. Dann, 564 F.2d 556, 566, 195 USPQ 97, 105 (D.C. Cir 1977), (since the USPTO is an executive branch agency, it must follow the strict provisions of the applicable statute).

Even If the USPTO Has the Discretion and the Authority to Remove the Recorded Terminal Disclaimer, the Record Does Not Show Such Relief Is Warranted

While petitioner may now consider the previously filed disclaimer to be unnecessary, or unnecessarily limiting, petitioner is, nevertheless, confronted with what has been characterized as “an unhappy circumstance,” rather than an “extraordinary” circumstance necessitating relief. See In re Jentoft, 392 F.2d 633, 639 n. 6, 157 USPQ 363, 368 n. 6 (CCPA 1968); MPEP 1490(A). As recounted by the Federal Circuit in Bayer AG v. Carlsbad Technology Inc., 64 USPQ2d 1045, 1048-49 (Fed. Cir. 2002)(upholding the district court deferring to the USPTO interpretation of its regulations and holding that *inter alia*, the terminal disclaimer could not be removed), the USPTO considers that the rules of practice do not provide for the withdrawal of a terminal disclaimer. § 253, which permits filing of a terminal disclaimer and “dedication to the public” of the terminal part of the term, does not include a mechanism for the withdrawal or amendment of a terminal disclaimer. The USPTO also considers that clarification of the disclaimed date is not the correction of a clerical or typographical mistake under 35 U.S.C. § 255 and 37 C.F.R. §1.323. *Id.* Even assuming, for the sake of argument, that the USPTO has the discretion and the authority in

⁵ In Geneva Pharmaceuticals v. GlaxoSmithKline, 68 USPQ2d 1865 at 1872 (Fed. Cir. 2003), the court discerned an extended, unexplained delay in prosecution of the various inventions among several patents, noted that 35 U.S.C. § 121, if misapplied, can extend patent term for patentably indistinct inventions, and given the potential windfall for patentees that such an inappropriate patent term extension could provide, the court would apply a strict test for application of the shielding effect of § 121. Here, as petitioner’s 4 year delay remains unexplained and during that time the public has had over 4 years to rely on the terminal disclaimer recorded against the patent by way of operation of 35 U.S.C. § 253 and 37 CFR 1.321(b), any windfall afforded by removal or amendment of the disclaimer in question would militate against waiver of the rules. Indeed, as a general rule, public policy does not favor the restoration to the patentee of something that has been freely dedicated to the public, particularly where the public interest is not protected in some manner. See Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U.S. 477, 24 USPQ 308 (1935). Petitioner does not indicate how the public interest in this instance would be protected, were the previously recorded terminal disclaimer removed or amended.

this instance to waive those rules unspecified by petitioner such that the contested terminal disclaimer may be withdrawn or amended, petitioner has failed to provide an adequate showing of why this is an "extraordinary situation" such that "justice requires" waiver. Unless a "mistake" is provided for in 37 CFR 1.322, 1.323, or 1.324, or affords legal grounds for reissue or for reexamination, such "mistake" will not be corrected subsequent to the issuance of an application as a patent. See 37 CFR 1.325: MPEP 1490(B). As further noted in MPEP 1490, the mechanisms to correct a patent (i.e., certificate of correction (35 U.S.C. § 255), reissue (35 U.S.C. § 251 (notwithstanding the filing of this reissue application and the instant petition) and reexamination (35 U.S.C. § 305)) are not available to withdraw or otherwise nullify the effect of a recorded terminal disclaimer.

Petitioner's request for issuance of a Certificate of Correction under 35 U.S.C. § 254 to correct the alleged error in the expiration date of the above-identified patent is refused.⁶ By statute (§ 254) and regulation (37 CFR 1.322), for a Certificate of Correction to lie, there must be (1) a mistake in the patent that is (2) clearly disclosed by the records of the Office. However, the records of the Office do not clearly disclose a mistake in the patent within the meaning of the statute and regulation. Petitioner is reminded that this or any patent is printed in accordance with the record in the USPTO of the application as passed to issue by the examiner. Here, the original application for patent was passed to issue by the examiner on September 17, 1996, upon receipt of the terminal disclaimer filed September 6, 1996, which set forth that it "disclaims...the terminal part of the statutory term of any patent granted on the above-identified application, which would extend beyond the expiration date of the full statutory term of U.S. patent No. 5,460,677." The as-printed patent states: "[T]he term of this patent shall not extend beyond the expiration date of Pat. No. 5,460,677." Thus the as-printed patent accurately reflects the contents of the terminal disclaimer, such that there is no mistake which is clearly disclosed by the records of the Office.

While petitioner also proposed amending the terminal disclaimer by way of a Certificate of Correction, the alleged error is not an error within the meaning of 35 U.S.C. § 254 and 37 CFR 1.322, and even assuming it were such an error it is not subject matter for and amenable to the proposed correction by the proffered Certificate of Correction under 35 U.S.C. § 254 and its promulgating regulation 37 CFR 1.322. What is here controlling is that petitioner seeks to correct an issued patent. The statutory authority for amendment or correction of an issued patent is found in title 35, chapter 25. The instant petition does not involve correction of the named inventor which is provided for by 35 U.S.C. § 256 and 37 CFR 1.324, which is, by statute, a part of the patent (i.e., "shall contain"). See 35 U.S.C. § 154(a)(1). In addition, 35 U.S.C. § 254 merely authorizes the correction of the patent; it does not authorize correction of a terminal disclaimer. Unless a "mistake" is provided for

⁶ Although petitioner does not seek a certificate of correction under 35 U.S.C. § 255 and 37 CFR 1.323, such is also immaterial, as explained in MPEP 1490(B).

in 37 CFR 1.322, 1.323, or 1.324, or affords legal grounds for reissue or for reexamination, such "mistake" will not be corrected subsequent to the issuance of an application as a patent. See 37 CFR 1.325: MPEP 1490.

The contested terminal disclaimer clearly complies with 37 CFR 1.321(b). While petitioner speculates that the public would recognize, upon inspection of the patent file⁷, that the common ownership requirements of 37 CFR 1.321(c)(3) were not met by the recorded disclaimer, common ownership is not a condition required for a viable terminal disclaimer under 37 CFR 1.321(b). Indeed, even where 37 CFR 1.321(c)(4) requires common ownership, such is mentioned in conjunction with enforcement *vel non* of the disclaiming patent and is not mentioned in conjunction with, or as a condition of, the forfeiture of a given period of time. Furthermore, as there is but a single date of expiration mentioned in the terminal disclaimer filed September 6, 1996, that disclaimer is clear and unambiguous. As such, there is no need to correct the records of the USPTO to resolve any ambiguity in the original terminal disclaimer or the as-issued original patent, unlike the situation reported in Bayer, supra. The USPTO will not grant a request to withdraw or amend a recorded disclaimer in an issued patent on the grounds that the rules of practice and 35 U.S.C. § 253 do not include a mechanism for withdrawal or amendment of such a disclaimer. Id.; see also MPEP 1490. Petitioner's contention that the USPTO has misinterpreted Bayer with the unfortunate result herein of not permitting removal or correction of the terminal disclaimer filed September 6, 1996, is not persuasive. The USPTO neither withdrew nor failed to give effect to the terminal disclaimer recorded against the Bayer patent. Id. The USPTO noted that the two dates recited in the recorded terminal disclaimer created an ambiguity as to the date of expiration, and resolved the ambiguity in favor of the patent holder. Id. The USPTO did not vacate or amend the recorded terminal disclaimer, or accept a substitute disclaimer in lieu of the recorded disclaimer, notwithstanding the ambiguity in the recorded terminal disclaimer. Id. The Federal Circuit noted with the approval the USPTO's underlying reasoning and its conclusion. Id. The court itself noted the date of expiration of the Bayer patent was automatically extended by operation of the URAA amendments to the patent statute on the term of the patent referenced in the recorded terminal disclaimer. What is especially significant is that the USPTO and the Federal Circuit both considered the recorded but flawed terminal disclaimer to remain in

⁷ The public is entitled to rely upon the public record, including the prosecution history, of a patent in determining the scope of the patent's claims. See Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1583, 39 USPQ2d 1573, 1577 (Fed. Cir. 1996); Vectra Fitness v. TNWK Corp., 162 F3d 1379, 1384, 49 USPQ2d 1144, 1148 (Fed. Cir. 1998). This reliance enables businesses, as well as others, to plan their future conduct in as certain an environment as possible. Vitronics, Id. Here, the public has had 4 years to observe this patent's facial representation that its term expires on the same date as U.S. 5,460,677, which is consistent with the contents of the patent file.

force on the Bayer patent. Id. Applying the facts of that case to the present situation, the terminal disclaimer of September 6, 1996, properly remains recorded against the issued patent and that disclaimer will not be withdrawn or amended on petition. See Bayer, supra; MPEP 1490(B). Any failure of that terminal disclaimer to disclaim over the '980 patent has been remedied by the filing of the corrective terminal disclaimer filed July 3, 2002.

Furthermore, equitable powers should not be invoked to excuse the performance of a condition by, as here, a party that has not acted with reasonable, due care and diligence. U.S. v. Lockheed Petroleum Services, 709 F.2d 1472, 1475 (Fed. Cir. 1983). As noted in the decision of June 28, 2004 (at 5-6), petitioner had nine months in which to correct, under the provisions of MPEP 1490(A), the filing of the disclaimer of September 6, 1996, before the patent issued. After issuance, an additional 4 years during which the issued patent and file contents were publicly available—and observable—elapsed before petitioner sought to remedy the disclaimer in question. It is well settled that the public has a right to rely on the public record of a patent. See Vitronics Id.; Vectra Fitness, Id. Petitioner does not offer any reason that would excuse the inordinate delay in this case. Any contention that petitioner was diligent in seeking correction of this matter is simply not supported by the record. The Office, where it has the power to do so, should not relax the requirements of established practice in order to save an applicant from the consequence(s) of his delay. See Ex Parte Sassin, 1906 Dec. Comm'r. Pat. 205, 206 (Comm'r Pat. 1906) and compare Ziegler v. Baxter v. Natta, 159 USPQ 378, 379 (Comm'r Pat. 1968) and Williams v. The Five Platters, Inc., 510 F.2d 963, 184 USPQ 744 (CCPA 1975).

37 CFR 1.183 should not be considered a panacea for applicant's tactical errors in prosecution in the original patent, as the failure to file a disclaimer over the patent actually relied upon in the obviousness-type double patenting rejection was a circumstance that was not beyond the control of petitioner, or petitioner's counsel. Rather, as any disclaimer of additional term over the '677 patent could have been avoided the by exercise of reasonable care and diligence, petitioner has failed to show that waiver of the rules is appropriate. See Nitto Chem. Indus. Co. v. Comer, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (circumstances are not extraordinary, and do not require waiver of the rules, when counsel makes an avoidable mistake in filing papers); Vincent v. Mossinghoff, 230 USPQ 621, 625 (D.D.C. 1985)(petitioner's failure to take adequate notice of USPTO procedures will not be permitted to shift, in equity, his lack of diligence onto the USPTO). The Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987).

DECISION

For the reasons given in the decision of June 4, 2004, and also noted above, the petition is DENIED as to the request for extraordinary relief and withdrawal or modification of the terminal disclaimer filed September 6, 1996 and recorded against the '345 patent.

This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02. The USPTO will not give further consideration or reconsideration to this matter.

Telephone inquiries related to this decision should be directed to Petitions Examiner Brian Hearn at (703) 305-1820.

A handwritten signature in black ink, appearing to read "Charles Pearson", with a long horizontal flourish extending to the right.

Charles Pearson, Director
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy